



Docket No.: 66729/P017US/10405597
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark Lesswing et al.

Application No.: 09/577,386

Confirmation No.: 3851

Filed: May 23, 2000

Art Unit: 3626

For: NOVEL METHOD AND APPARATUS FOR
REPRICING A REIMBURSEMENT CLAIM
AGAINST A CONTRACT

Examiner: V. Frenel

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 CFR §1.144

Director for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.144, Applicant respectfully petitions the Director to reconsider and withdraw the Restriction Requirement raised in the Office Action mailed September 21, 2004 for the above-identified patent application.

Statement of Facts

The present patent application was filed May 23, 2000 with 59 claims, numbered 1-59. A first Office Action, which included an examination of all 59 claims, was mailed August 27, 2003. In response, Applicant submitted an Amendment on November 13, 2003. A Final Office Action, which again included an examination of all 59 claims, was mailed February 13, 2004.

On June 14, 2004, Applicant filed a Request for Continued Examination (RCE) with an accompanying amendment, which included previously examined claims 1-59 and added

new claims 60-86, thus resulting in claims 1-86 pending in the application. An Office Action was mailed September 21, 2004, which raised the Restriction Requirement now at issue.

The September 21, 2004 Office Action required restriction between the following claim groups:

I. Claims 1-11 and 24-70 drawn to a computer for repricing an electronically received reimbursement claim, classified in class 705, subclass 4;

II. Claims 12-23, drawn to an electronically received reimbursement claim for medical services, classified in class 705, subclass 203; and

III. Claims 71-86, drawn to a computer-executable code for generating a user interface, which classified in class 345, subclass 700.

The Office Action asserted that claim groups I, II, and III are distinct from each other because they are related as subcombinations usable together in a single combination and are separately usable. *See* item 3 on page 2 of the September 21, 2004 Office Action.

Applicant traversed this restriction requirement and requested reconsideration pursuant to 37 C.F.R. § 1.143 in a Response submitted October 19, 2004. However, the Examiner maintained and made final the Restriction Requirement in an Office Action mailed August 3, 2005. The August 3, 2005 Office Action which asserted that the Restriction Requirement was maintained and made final included an examination of not only the provisionally elected claims 1-11 and 24-70 (group I), but also claims 71-86 (group III). Accordingly, all of claims 1-59 were searched and examined prior to Applicant's RCE, and all of the further claims 60-86 have been searched and examined as of the August 3, 2005 Office Action.

Applicant respectfully petitions that the Director reconsider and withdraw the outstanding Restriction Requirement for the reasons provided in the following remarks.

Remarks

In general, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. M.P.E.P. § 803. As discussed below, the September 21, 2004 Office Action failed to properly establish that the claims of groups I-III are independent or distinct. Further, a serious burden would not be placed on the Examiner if the restriction between these groups of claims is not required because the Examiner has already searched and examined all of the claims.

I. Restriction between Groups I and II is improper

Applicant respectfully submits that restriction between the identified groups I and II is improper.

A. The Claims of Groups I and II Have Not Been Established to be Independent or Distinct

First, the Office Action has failed to establish that the claims of groups I and II are independent or distinct. Applicant fails to understand why claims 12-23 (group II) have been classified as drawn to different subject matter than that identified for claims 1-11 and 24-70 (group I). The September 21st Office Action contends that claims 1-11 and 24-70 (group I) are drawn to a computer for repricing an electronically received reimbursement claim. Claim 1, for example, recites “A computer implemented method of repricing an electronically received reimbursement claim under at least one contract”. Similarly, claim 12 recites “A computer implemented method of repricing at least one electronically received reimbursement claim, for medical services, under at least one contract comprising providing programming code for ...”. Thus, as with claim 1 (of group I), claim 12 is directed to a computer implemented method of repricing an electronically received reimbursement claim under a contract. While claim 12 specifies that the received claim for reimbursement is for medical services, claim 12 is directed to a repricing method, just as claim 1.

Accordingly, claims 1 and 12 are not drawn to subcombinations that are usable together, as alleged by the September 21st Office Action, but are instead both drawn to repricing methods. For instance, the repricing method of claim 1 may be used for repricing a

reimbursement claim for medical services, just as with claim 12. Therefore, Applicants respectfully submit that distinctness as between claim groups I and II has not been properly established.

B. No SERIOUS BURDEN Has Been Established For Examining Groups I and II

Additionally, if “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803. The September 21st Office Action fails to adequately establish that such a serious burden would arise in the present case if the restriction is not made. First, claims 1 and 12 have been previously searched and examined for this application, prior to the filing of the Request for Continued Examination (RCE) on June 14, 2004.

The present application was filed with 59 claims, numbered 1-59. An Office Action was mailed August 27, 2003, which examined (and rejected) all of such claims 1-59. Claims 1 and 12 were thus searched and examined by the Examiner in the August 27th Office Action. Further, neither of claims 1 nor 12 have been substantially amended since such examination, so as to raise a serious burden in continued examination of these claims. Indeed, the only amendments made to these claims were submitted in Applicant’s Amendment of November 13, 2003 in which claims 1 and 12 were amended to recite a “computer implemented” method, as suggested by the August 27, 2003 Office Action. A Final Office Action was then mailed February 13, 2004, which again included an examination of all 59 claims. Thus, because these claims have been examined together, Applicant respectfully submits that no SERIOUS burden would arise in these claims remaining together in the continued examination of the present application.

Additionally, as explained further below, like elements to those required to be searched and examined for the provisionally elected group of claims (group I) are also present in claim 12 (of group II). For instance, similar elements to those recited in claim 12 (of group II) are found in claim 1 (of group I), and therefore a search and examination of these similar elements will be required anyway.

For example, the first element of claim 12 recites “inputting into a platform, each contract, of the at least one contract, each contract containing a contract identifier code and a series of contractual terms, each contractual term being defined by qualification codes, calculation codes and at least one priority note”. Claim 1 recites “providing programming code for converting each contract into a plurality of terms and a contract identifier code, each term, of the plurality of terms, containing qualification codes, calculation codes and at least two priority notes, and arranging the plurality of terms, of said contract, into a sequential series of terms”. Thus, each of claims 1 and 12 will require a search and examination of a contract that contains a contract identifier code and a series of contractual terms that each define/contain qualification codes, calculation codes, and a priority note (claim 12 recites “at least one priority note”, while claim 1 recites “at least two priority notes”).

The second element of claim 12 recites “inputting into a platform, each claim, of the at least one claim, each claim containing a second identifier code and a series of claim lines, wherein each claim line being defined by a claim code, a unit number and a corresponding charge”. Claim 1 recites “providing programming code for converting the reimbursement claim into a series of claim lines, each claim line containing a claim code, a unit number and a corresponding charge”. Thus, each of claims 1 and 12 will require a search and examination of a claim that includes a series of claim lines that are each defined by/contain a claim code, a unit number, and a corresponding charge.

The third element of claim 12 recites “requesting a platform to reprice a claim, of the at least one claim, by determining a reimbursement amount for said claim”. Claim 1 recites “providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms”. Thus, each of claims 1 and 12 will require a search and examination of determining a reimbursement amount for a claim.

Claim 12 further recites “requesting a platform to display the reimbursement amount for said repriced claim.” Claim 1 does not recite a similar element. However, independent claim 24, which is also included in group I with claim 1, recites “causing a computer to graphically display the reimbursement amount of the repriced claim”.

In view of the above, very similar elements are required to be searched and examined in claim 12 of group II as are present in the claims of provisionally elected group I. Accordingly, Applicant respectfully submits that the Examiner has failed to establish that a SERIOUS burden exists if the claims of group II are not restricted from those of group I, and therefore the restriction requirement as between groups I and II should be withdrawn.

II. Restriction between Groups I and III is improper

Applicant respectfully submits that restriction between the identified groups I and III is improper.

A. The Claims of Groups I and III Have Not Been Established to be Independent or Distinct

The September 21st Office Action also asserts that claims 71-86 (group III) are drawn to computer-executable code for generating a user interface. While claim 71 recites “Computer-executable software code stored to a computer-readable medium, the computer-executable software code comprising: code for generating a user interface ...”, other claims in group III are not drawn to generating a user interface. Claim 84, for example, recites:

A method for determining a reimbursement amount for a claim,
comprising:

defining a reimbursement contract in computer-executable program code stored to a computer-readable medium, where said definition of said reimbursement contract includes information associating at least one term of the contract with at least one qualifier having a corresponding calculation method;

receiving into a processor-based device, information about a claim received for reimbursement; and

said processor-based device determining a reimbursement amount for the claim based at least in part on the defined reimbursement contract.

Thus, claim 84 of group III is not drawn to computer-executable code for generating a user interface, but is instead directed to a method for determining a reimbursement amount of a claim, similar to those claims of group I. Accordingly, the Office Action has failed to establish that at least claim 84 and claims 85-86 (which depend from claim 84) of group III are independent and distinct should not be restricted from the claims of group I. Therefore, this restriction should be withdrawn.

B. No SERIOUS BURDEN Has Been Established For Examining Groups I and III

As discussed above, if “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803. The September 21st Office Action fails to adequately establish that such a serious burden would arise in the present case if the restriction is not made. Further, claims 71-86 have now been searched and examined for this application. That is, the Office Action mailed August 3, 2005, which maintained and made final the above Restriction Requirement, not only examined provisionally elected claims 1-11 and 24-70, but also included an examination of claims 71-86, *see* rejection under 35 U.S.C. § 103 on page 3 of the August 3rd Office Action. As explained above, claims 1 and 12 have been previously searched and examined prior to the filing of the Request for Continued Examination (RCE) on June 14, 2005. Now, the further claims 71-86 have been searched and examined in the Office Action of August 3, 2005. Thus, because all of the currently pending claims 1-86 have been searched and examined, Applicant respectfully submits that no serious burden would arise by maintaining these claims together in the continued examination of the present application.


Conclusion

In view of the above, Applicant respectfully traverses the restriction requirement of the September 21, 2004 Office Action as improper. Therefore, Applicant respectfully petitions the Director to reconsider and withdraw the outstanding Restriction Requirement for the reasons discussed above.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 66729/P017US/10405597 from which the undersigned is authorized to draw.

Dated: December 2, 2005

Respectfully submitted,

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ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Reply to Missing Parts/Incomplete Application

☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)

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